

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

PARTS ID, LLC,

Plaintiff,

v.

IDPARTS LLC,

Defendant.

Civil Action No. 20-cv-11253-RWZ

IDPARTS LLC,

Counterclaim Plaintiff,

v.

PARTS ID, LLC and PARTS ID, INC.,

Counterclaim Defendants.

**IDPARTS LLC'S LOCAL RULE 56.1 STATEMENT
IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT**

Pursuant to Local Civil Rule 56.1, Defendant and Counterclaim Plaintiff IDParts LLC, ("IDParts") submits the following statement of material facts of record as to which IDParts contends there is no genuine issue of fact to be tried.

STATEMENT OF UNDISPUTED MATERIAL FACTS

1. IDParts began using an "ID" mark, as shown below (with the mark blown up from an image of its original web page), to sell automotive parts on the internet at least as early as January 2010:



Decl. of Corey Evans (“Evans Decl.”) (filed herewith), ¶ 3; Ex. B, IDParts Website, at <https://www.idparts.com/> (Jan. 5, 2010 Web Capture).

2. Since January 2010, IDParts has used an ID mark, such as the one shown in paragraph 1, in connection with the sale of automotive parts on the internet. Evans Decl., ¶ 9; Ex. C, IDParts Website, at <https://www.idparts.com/> (Aug. 14, 2011 Web Capture); Ex. D, IDParts Website, at <https://www.idparts.com/> (Feb. 22, 2012 Web Capture); Ex. E, IDParts Website, at <https://www.idparts.com/> (Aug. 5, 2013 Web Capture); Ex. F, IDParts Website, at <https://www.idparts.com/> (Apr. 19, 2015 Web Capture); Ex. G, IDParts Website, at <https://www.idparts.com/> (June 6, 2017 Web Capture); Ex. H, IDParts Website, at <https://www.idparts.com/> (Aug. 4, 2020 Web Capture).

3. Plaintiff PARTS iD—formerly Onyx Enterprises Int’l Corp. (“Onyx”)—did not begin using the ID mark alone, with no modifier such as “car,” until 2013. *See* Ex. I, PARTS iD Website, at <https://www.carid.com/> (Nov. 29, 2013 Web Capture); Ex. M, PARTS iD Website, at <https://www.carid.com/> (Aug. 9, 2011 Web Capture); Ex. J, Trademark File Wrapper for U.S. Registration No. 5,658,672 “ID (stylized)”; Ex. L, Trademark File Wrapper for U.S. Registration

No. 6,096,254 “ID (stylized)”; Ex. K, Trademark File Wrapper for U.S. Registration No. 5,804,750 “ID (stylized).”

4. Prior to 2013, PARTS iD / Onyx always used the mark CARID and did not use the mark ID alone, with no modifier such as “car.” Ex. M, PARTS iD Website, at <https://www.carid.com/> (Aug. 9, 2011 Web Capture); Second Amended Complaint (“Complaint”) (Dkt. 29), ¶ 13.

5. On April 16, 2014, Onyx filed Application No. 86/253,327 for the following design mark, which eventually issued as U.S. Registration No. 5,658,672 on January 22, 2019:



Ex. J, Trademark File Wrapper for U.S. Registration No. 5,658,672 “ID (stylized).”

6. In U.S. Registration No. 5,658,672, Onyx claims its “First Use Anywhere Date” as “at least as early as 09/01/2013” and its “First Use in Commerce Date” as “at least as early as 09/01/2013”. Ex. J, Trademark File Wrapper for U.S. Registration No. 5,658,672 “ID (stylized).”

7. On November 29, 2018, Onyx filed Application No. 88/211,256 for the following design mark, which eventually issued as U.S. Registration No. 5,804,750 on July 16, 2019:



Ex. K, Trademark File Wrapper for U.S. Registration No. 5,804,750 “ID (stylized).”

8. In U.S. Registration No. 5,804,750, Onyx claims its “First Use Anywhere Date” as “at least as early as 06/01/2018” and its “First Use in Commerce Date” as “at least as early as 06/01/2018” and that “[t]he mark was first used anywhere in a different form other than that

sought to be registered at least as early as 09/01/2013.” Ex. K, Trademark File Wrapper for U.S. Registration No. 5,804,750 “ID (stylized).”

9. On December 19, 2019, Onyx filed Application No. 88/734,396 for the following design mark, which eventually issued as U.S. Registration No. 6,096,254 on July 7, 2020:



Ex. L, Trademark File Wrapper for U.S. Registration No. 6,096,254 “ID (stylized).”

10. In U.S. Registration No. 6,096,254, Onyx claims its “First Use Anywhere Date” as “at least as early as 06/01/2018” and its “First Use in Commerce Date” as “at least as early as 06/01/2018.” Ex. L, Trademark File Wrapper for U.S. Registration No. 6,096,254 “ID (stylized).”

11. Neither PARTS iD nor Onyx owns any federal trademark registrations for the mark ID alone apart from U.S. Registration Nos. 5,658,672; 5,804,750; and 6,096,254.

12. PARTS iD admits in its Complaint that IDParts’ use of its ID mark will cause consumer confusion with PARTS iD’s use of its ID marks and, therefore, the opposite is also true. *See, e.g.*, Complaint (Dkt. 29), ¶ 79 (“Defendant’s unauthorized use of Plaintiff’s iD® Mark, and/or confusingly similar variations thereof, is causing and is likely to continue to cause confusion, or to cause mistake, or to deceive, consumers and the relevant public into falsely believing that ID Parts is affiliated, connected, or associated with Plaintiff’s iD® Mark.”).

Respectfully submitted,

Date: February 26, 2021

/s/ John L. Strand

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CERTIFICATE OF SERVICE

I certify that this document is being filed through the Court's electronic filing system, which serves counsel for other parties who are registered participants as identified on the Notice of Electronic Filing (NEF). Any counsel for other parties who are not registered participants are being served by first class mail on the date of electronic filing.

/s/ John L. Strand

John L. Strand